Remarks

Claims 1-5 are pending in the subject application and before the Examiner for his consideration. In view of the remarks set forth below, favorable consideration of the claims now presented is earnestly solicited.

As an initial matter, the applicants and the applicants' representatives wish to thank Examiner Mercado and Supervisory Primary Examiner Ryan for the courtesy of the personal interview conducted with the applicants' representatives, including the undersigned, on August 9, 2004, regarding the rejection under 35 U.S.C. §103(a). The remarks set forth herein are consistent with the substance of the interview, constitute a Statement of Substance of the Interview as required under 37 CFR 1.133(b), and are believed to address the outstanding issues as discussed during the interview.

Claims 1-5 have been rejected under 35 U.S.C. § 103(a) as obvious over Kita *et al.* (JP 10-112335) in view of the Merck Chemical Database. The applicants respectfully submit that the claimed invention is patentable over the electrolytic solution disclosed in the Kita *et al.* reference, even in view of the Merck Chemical Database.

Kita *et al.* teach that increasing the ratio of fluorobenzene in solution beyond 10 part by weight may deteriorate the properties of an electrolytic battery and is undesirable (paragraph 11). In contrast, the present inventors found that increasing amounts of fluorobenzene improves the low temperature performance cell life of an electrolyte solution. As shown in Tables 1, 2 and 3 of the subject specification, electrolytic solutions having a volume percent of fluorobenzene as set forth in the applicant's claims exhibit excellent battery performance.

The mere fact that the purported prior art could have been modified or applied in a manner to yield the applicant's invention would not have made the modification or application obvious unless the prior art suggested the desirability of the modification. *In re Gordon*, 221 USPQ 1125, 1127 (Fed. Cir. 1984). Moreover, as expressed by the CAFC, to support a §103 rejection, "[b]oth the suggestion and the expectation of success must be founded in the prior art . . . ." *In re Dow Chemical Co.*, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988). One finds neither in Kita *et al.* in support of a §103 rejection.

The Merck reference does not cure the aforementioned defects of the Kita *et al.* reference.

Therefore, a person skilled in the art, having reviewed the Kita *et al.* reference, would not have been motivated to increase the amount of FB to that which is used in the subject invention with an expectation of achieving the highly-desirable and unexpected results of the claimed invention. Accordingly, the applicants respectfully request reconsideration and withdrawal of the rejections set forth under 35 U.S.C. §103.

In view of the foregoing remarks the applicants believe that the currently pending claims are in condition for allowance, and such action is respectfully requested.

The Commissioner is hereby authorized to charge any fees under 37 CFR §§1.16 or 1.17 as required by this paper to Deposit Account No. 19-0065.

The applicant invites the Examiner to call the undersigned if clarification is needed on any of this response, or if the Examiner believes a telephone interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,

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